

REMARKS

This application has been carefully reviewed in light of the Office Action dated April 29, 2003. Claims 1-19 remain now pending in this application. Claims 1 and 19 are the independent claims. Favorable reconsideration is respectfully requested.

On the merits, the Office Action rejected Claims 1-5, 7, and 17-19 under 35 U.S.C. § 103(a) as being unpatentable over Kawahara et al. (U.S. Patent No. 5,810,463; hereinafter "Kawahara") in view of Schumacher et al. (U.S. Patent No. 5,921,670; hereinafter "Schumacher"). The Office Action also rejected Claims 8-11, 13 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Kawahara in view of Schumacher and Endo et al. (U.S. Patent No. 5,123,077; hereinafter "Endo"). The Office Action also rejected Claims 6, 12, and 14-15 under 35 U.S.C. § 103(a) as being unpatentable over Kawahara in view of McGaffigan (U.S. Patent No. 6,031,958; hereinafter "McGaffigan"). Applicants respectfully submit that the pending claims are patentable for at least the following reasons.

Applicants' Claim 1 recites: "[a] side-emitting illumination device for uniformly distributing light comprising: an LED light source, a light-transmitting rod which permits total internal reflection, and outcoupling material affixed to an outer surface of the rod, wherein the angular width of the outcoupling material

affixed to an outer surface of the rod controls the angular distribution of light leaving the side of the rod."

As stated in the Office Action, Kawahara fails to recite or suggest that the width of the outcoupling material controls the angular distribution of light leaving the side of the rod.

Schumacher recites an extractor 12 whose width, as defined as thickness in Schumacher, increases "with its distance from the light source 9, whereby any decrease in decoupled light quantity further away from the light source is compensated" (Col. 4, lines 43-47). Thus, the structure of Schumacher fails to compensate for that which Kawahara lacks. More specifically, Schumacher recites a hollow light guide 8 covered on its inner surface with an optical lighting film 10 which is provided with a light extractor 12 made of scattering film 13. (See, e.g., Col. 4, lines 28-49) Fig. 3A shows how the "width," as defined in Schumacher as thickness, becomes larger to control the outcoupling of light. Thus, as contrary to the Office Action's argument that the prior art is capable of performing the intended use, Applicants respond that Schumacher does not recite or suggest the angular width of the outcoupling material controlling the angular distribution of light leaving the side of the rod. Further, Schumacher and Kawahara fail to recite such a structural difference as the angular width of the outcoupling material controlling. Rather, the extractor 12 of

Schumacher increases in thickness and therefore is structurally and fundamentally different.

One of ordinary skill in the art, therefore, would not be motivated to use this coating for a hollow light guide with an emitting rod of Kawahara. M.P.E.P. § 706.02(j) states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The combination of Kawahara and Schumacher fail to provide the motivation to combine and reasonable expectation of success. Consequently, Claim 1 is believed patentable over Kawahara in view of Schumacher for at least these reasons.

Further, mere possibilities do not constitute grounds by which an obviousness rejection can be maintained without improper hindsight by "use[ing] the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention," see *In Re Denis Rouffet*, 47 USPQ.2d 1453, 1457-58 (Fed. Cir. 1998). This improper hindsight indicates an improper means by which to reject a claim.

Independent Claim 19 recites a method of controlling the angular distribution of light substantially corresponding to Claim 1 and is believed patentable for at least the same reasons.

Claims 2-18 depend from independent Claim 1 discussed above and are believed patentable for at least the same reasons. In addition, Applicants respectfully believe Claims 2-18 to be independently patentable and request separate consideration of each claim. In addition, Applicants respectfully believe the above amendments and remarks render the § 103 rejections of Claims 2-18 moot. Withdrawal of the § 103 rejections is respectfully requested.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned agent may be reached by telephone at the number given below.

Respectfully submitted,

FAX RECEIVED

By 
Aaron Waxler,
Reg. 48,027
(914) 333-9608
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TECHNOLOGY CENTER 2800